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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/638,102 | 08/11/2000 | David C. Schwartz | 960296.97133 | 7761 |

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EXAMINER

DAVIS, DEBORAH A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1641

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,102

Applicant(s)

SCHWARTZ, DAVID C.

Examiner

Deborah A. Davis

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-, 2, 5-7, 9-13, 41, 43-52 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 2, 5-7, 9-13 and 35 is/are allowed.
6) ☒ Claim(s) 41, 43-52 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 18, 2005 has been entered.
2. Applicants' response to the Office Action mailed on October 19, 2004 has been acknowledged. Currently, claims 41, 43-52 are pending and under examination, claims 3-4, 34, 36-40, and 42 are cancelled, claims 14-33 are withdrawn from consideration and claims 43-52 are newly added.

Information Disclosure Statement

3. information disclosure statement that applicant mentions in the Remarks/Arguments of the amendment filed February 18, 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because a copy of the IDS has not been received. Therefore, the prior art references will not be considered until a copy of the IDS has been received by the examiner.

Claim Rejections - 35 USC § 112

4 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5 Claims 41, and 43-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation in the preamble "Chemical screening kit" of claims 41, 43-52 is not found in the specification. Specifically, the term "kit" or the description thereof is not present in the specification in such a way that would allow one of ordinary skill in the art recognize its structure. Applicant is invited to show support to obviate this rejection.

Claim Rejections - 35 USC § 103

6 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7 Claim 41, 43, 45-46, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al (USP# 4,867,946) in view of Zuk et al (USP#4,281,061).

The instant claimed invention is drawn to a **chemical screening kit** which examiner still maintains applicant has not shown support for this limitation. The teaching of Gross et al was cited against the kit claims in the Office Action mailed October 19, 2004 and are set forth below for convenience.

Gross et al teaches the instant claims by teaching a device for evaluating test strips used to screen a variety of different samples. The test strips contain several test sections where the reagents are placed for testing (col. 1, 2nd para and see Figure 2). The device has a platform and a holder to support the test strips (col. 2, see claim 1) in a parallel relationship in which the test strips are perpendicular to the holder (see Figure 2). The test strip has test sections spaced along the strips to allow samples to be deposited (see Figure 2).

Although the reference of Gross et al teaches the components of the instant claimed invention, they are silent with respect to a kit.

However, Zuk et al. teaches that "as a matter of convenience the reagents can be provided as kits, where the reagents are in predetermined ratios, so as to substantially optimize the sensitivity of the assay in the range of interest" (column 22, lines 63-66).

It would have been prima facie obvious to one of ordinary skill in the art at the time of applicant's invention to take the reagents and other materials as taught by Gross et al and format them into a kit because Zuk et al. teach that it is convenient to do so

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and one can enhance sensitivity of a method by providing reagents as a kit along with other materials. One in the art would be motivated to because the reagents in a kit are available in pre-measured amounts which eliminates the variability that can occur when performing the assay

8 Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al in view of Zuk and in further view of Adams (USP#6,156,494).

The teachings of Gross et al in view of Zuk et al are set forth above but is silent with respect to the strips being glass fibers.

However, Adams et al teaches methods for utilizing optical fibers as a solid support for the assembly of combinatorial compounds. The optical fibers are used to direct light, heat or a combination thereof (see abstract).

It would have been obvious to one of ordinary skill in the art to modify the teaching of Gross et al to include glass fiber strips as taught by Adams et al to direct heat and light or a combination thereof to compounds on the surface of the fibers (see abstract) so compounds can be screened for binding activity.

9 Claims 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al in view of Zuk et al and in further view of Bensten et al ((USP#6,372,895).

The teachings of Gross et al are set forth above and differ in the instant invention because it does not particularly point out strips that include a marker selected from the group of printing and fluorescent material.

However, Bentsen et al teaches in one of his embodiments an apparatus that uses a test strip that contains a printed barcode wherein the printed material on the barcode has an enzyme or spore. The strip is further sterilized and dipped into a buffer solution containing Fluorescence Enzyme Substrate (FES). If enzyme activity is present, the printed pattern will become detectable (col. 20, lines 66-67 and col. 21, 1st para).

It would have been obvious to one of ordinary skill in the art to have incorporate the printed barcode as taught by Bentsen et al into the strips of Gross et al to detect enzyme activity.

Allowable Subject Matter

10. Claims 35, 2, 5-7, and 9-13 are allowed. Claims are allowable for reasons stated in the previous office action mailed October 19, 2005.

Response to Arguments

11. Applicant argument that support exists for a kit in the instant specification and has directed the examiner's attention to several sections in the specification that applicant maintain describes a kit configuration. This argument is noted but not found to be persuasive.

In response to applicant's argument, the sections of the specification that applicant is referring to describe the benefits of the invention and how screening of arrays can be realized on a large scale. In particular, page 10, lines 7-17 of the

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specification, describes robotic techniques in the manufacture of the arrays and also describes the different elements of the array. Therefore, the examiner maintains that there is no support for the term kit nor for its construction in the instant specification.

Conclusion

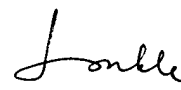
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Davis whose telephone number is (571) 272-0818. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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March 2, 2005



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SUPERVISORY PATENT EXAMINER
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03/05/05

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